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Jeffrey Scott Eder

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EXAMINER

CHENCINSKI, SIEGFRIED E

ART UNIT

PAPER NUMBER

3628

DATE MAILED: 05/09/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/761,670	Applicant(s) EDER, JEFFREY SCOTT	
	Examiner Siegfried E. Chencinski	Art Unit 3628	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 31 January 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 43-88 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 43-88 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>10/16/05, 12/31/05</u> . | 6) <input checked="" type="checkbox"/> Other: <u>IDS-PTO-1449 - 12/31/05</u> . |

DETAILED ACTION

Specification

1. The amendments to the first paragraph of the specification filed October 5, 2005 and December 5, 2005 have not been entered because they not conform to 37 CFR 1.125(b) and (c) because the later of the two time deadlines expired several years ago. At this time the only option available to an Applicant is to file a petition according to MPEP guidelines to have any of the proposed prior applications considered for a benefit claim to the instant application (see 37 CFR 1.78(A)(2) AND (a)(5)). (MPEP 1893.03(c)).

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

2. **Claims 43-88 are rejected under 35 U.S.C. 101** because the claimed invention is not supported by either a specific and substantial asserted utility or a well established utility.

For a claim to be statutory under 35 USC 101 the following two conditions must be met:

1) In the claim, the practical application of an algorithm or idea results in a useful, concrete, tangible result.

In this case, the claims do not produce a useful, concrete, tangible result because the claimed method is merely a conceptual framework. The limitations are made up of the evolving of a plurality of network models with input nodes, hidden nodes and output nodes, and relationships with degrees of influence and elements of value. All of these together are essentially vague and cannot even be considered an algorithm, which, in any case, as presented, fails to not even produce a useful, concrete, tangible quantitative result. In addition, court interpretations of the statute require that output in specific applications be claimed. Having such applications in the specification is insufficient. Further, even the most detailed disclosure in the specification fails to

present a method and system where the results can be replicated by others because qualitative judgments are involved in the method such that even the same practitioner seems unlikely to be able to replicate the same result for the same case in multiple iterations of operating the model. An ordinary practitioner of the art would be unable to make productive use of the claimed invention(s).

Claims 43-88 are also rejected under 35 U.S.C. 112, first paragraph.

Specifically, since the claimed invention is not supported by either a specific and substantial asserted utility or a well established utility for the reasons set forth above, one skilled in the art clearly would not know how to use the claimed invention.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claims 43-88 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. For an application in this case, see the rejection under 35 USC 101.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 43-88 are rejected under 35 U.S.C. 112, second paragraph, as being incomplete for omitting essential elements, such omission amounting to a gap between the elements. See MPEP § 2172.01. The omitted elements are the steps which would lead an ordinary practitioner of the art to successfully apply the invention to produce a concrete, reproducible quantitative valuation result of a firm.

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5. Claims 85 and 88 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The expressions "intelligent" in claim 85 and "direct effects" and "indirect effects" in claim 88 appear for the first time in these two claims added by amendment after the first Office Action. They do not appear in the disclosure.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claims 43-49, 51, 53-62 and 64-66 are rejected under 35 U.S.C. 102(e) as being anticipated by Sandretto (US Patent 5,812,988).

Re. claims 43, 54 & 67, Sandretto anticipates a firm analysis method, framework and medium, comprising:

- aggregating firm related data from a plurality of systems in accordance with a common data dictionary using at least a portion of the data to generate network models which connect one or more current elements of value of said firm to one or more aspects of financial performance of said firm (Col. 8, ll. 52-59), said network models being further comprised of:
- a computer with a processor, having circuitry to execute instructions; a storage device available to said processor with sequences of instructions stored therein, which when executed cause the processor to: obtain a plurality of data related to a value of a business enterprise in a format suitable for processing (Col. 15, ll. 23-67).
- one or more input nodes, hidden nodes and output nodes where each input node represents an element of value and each output node represents an aspect of financial performance (Sandretto, Col. 9, ll. 40-41. The input and output nodes are

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inherent or obvious), and

- a plurality of relationships where each relationship is a function of an impact of each element on other elements of value or an aspect of financial performance (Col. 8, l. 52 – Col. 9, l. 20);
- modifying said network models using one or more future scenarios, each scenario serving to modify the elements of value with consequent effects on the relationships and aspects of financial performance (Col. 8, ll. 66-67), and
- evaluating the scenarios in light of their impact on aspects of financial performance to determine which scenarios should be pursued (Col. 8, l. 64 – Col. 9, l. 20).

Re. Claims 44, 55 & 68, Sandretto anticipates one or more aspects of financial performance based on market value (Col. 9, ll. 11, 13, 30).

Re. Claims 45, 56 & 69, Sandretto anticipates network models which comprise: a summary of value drivers by element of value applied to each of said input nodes, where said summaries summarize the impact of each *of* said elements of value on one or more aspects of financial performance, the other elements of value and combinations thereof (Col. 9, 14-16).

Re. Claims 46, 57 & 70, Sandretto anticipates where one or more weights from a best fit model are used to identify a net impact of each element *of* value on a component of value selected from the group consisting of revenue, expense, capital change and combinations thereof (Col. 9, ll. 16-20, 56-57).

Re. Claims 47, 58 & 71, Sandretto anticipates comprising means for training best fit network models that identify a relative impact of each element on each *of* the components of value where one or more weights from the best fit models are used to identify a relative contribution of each element of value to each component of value net of any impact on the other elements of value (Col. 11, ll. 43-56).

Re. Claims 48, 59 & 72, Sandretto anticipates means for training one or more best fit network models that identify a relative impact of each element of value on market value where one or more weights from the best fit model are used to identify a relative contribution of each element of value to market value (Col. 9, ll. 11, 13, 30).

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Re. Claims 49, 60 & 73, Sandretto anticipates where a plurality of relationships are quantified for a specified point in time within a sequential series of points in time (Col. 10, ll. 1-7).

Re. Claims 53, 61 & 74, Sandretto anticipates where a relative contribution to one or more components of value is combined with a present value of said components of value to determine a current operation value of each element of value (Col. 9, ll. 7-9).

Re. Claims 51, 62 & 75, Sandretto anticipates the element of value of employees (Col. 16, ll. 27-30).

Re. Claims 64 & 77, Sandretto anticipates a firm as a company (Col. 2, ll. 22-26).

Re. Claims 65 & 78 Sandretto anticipates different scenarios are optionally valued and displayed using an electronic display (Col. 15, l. 30).

Re. Claims 66 & 79, Sandretto anticipates where firm related data includes data captured from an accounting and human resource system, (Col. 10, ll. 1-7).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 52, 63 and 76 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sandretto in view of Jost et al. (US Patent 5,361,201, hereafter Jost).

Re. Claim 52, 63 & 76, Sandretto does not explicitly disclose a method where network models further comprise neural network models. However, Jost discloses neural network models (Abstract- l. 3; Col. 1, l. 7-10; Col. 2, ll. 30-35). It would have been obvious to an ordinary practitioner of the art at the time of Applicant's invention to have combined the art of Sandretto with the art of Jost in order to provide a valuation method and system which makes use of neural network modeling, motivated by a desire to provide accurate estimates of financial value (Jost, Col. 2, ll. 17-20).

8. Claims 80-85, 87 and 88 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sandretto.

Re. Claims 80-84, Sandretto discloses:

Re. Claim 80, a firm analysis method, framework and medium (see the above rejections of claims 43, 54 & 67). In so doing, Sandretto also discloses an enterprise data integration method, comprising accessing a plurality of enterprise transaction data via an interface coupled to a plurality of data sources, and converting said transaction data to a common schema using an application software segment, and storing said converted data in a database for use in processing, where a plurality of sources further comprise databases for systems selected from the group consisting of a basic financial system, a human resource system, an advanced financial system, a sales system, an operations system, an accounts receivable system, an accounts payable system, a capital asset system, an inventory system, an invoicing system, a payroll system, a purchasing system and combinations thereof (Col. 9, ll. 40-41; Col. 10, ll. 1-7; Col. 14, l. 30 – Col. 15, l. 19; Fig's 1-14). Sandretto discloses in these and other sections of the patent how he integrates data from a multiplicity of databases and models to generate an analysis of a firm. The schematics show how the pieces are fit together in integrating the data and perform the analysis.

Re. Claim 81, an enterprise data integration method. Sandretto does not explicitly disclose a plurality of relational databases where said databases use different data formats. However, relational databases using different data formats were well known within the art at the time of Applicant's invention. They are implicitly in use in Sandretto's disclosure.

Re. Claim 82, a network connection (Col. 15, ll. 59-63; Fig's 1A).

Re. Claim 83, an enterprise data integration method. Sandretto does not explicitly disclose a network schema with a common data dictionary where said common data dictionary defines common attributes selected from the group consisting of elements of value, components of value, currencies, units of measure, time periods, dates and combinations thereof. However, a network schema and a data dictionary were well known and necessary

data processing system tools used for projects such as enterprise data integration. As such, they are implicitly in used in Sandretto's disclosure.

Re. Claim 84, the conversion and storage of data before processing begins. Conversion and storage of data before processing begins are implicit to Sandretta's disclosure since they are necessary steps in operating Sandretta's system.

Re. Claims 80-84, it would have been obvious to an ordinary practitioner of the art at the time of Applicant's invention to have used Sandretto's disclosure with the practitioner's own knowledge to make obvious adjustments in order to produce an enterprise data integration method, motivated by the desire to offer a valuation model which fully utilizes current information that affects asset risk and which can be used for virtually any asset and potential asset (Sandretto, Col. 9, ll. 56-67).

Re. Claim 85, Sandretta discloses an intelligent method for analyzing commerce data using a computer, comprising: identifying a set of data required for analyzing a commercial enterprise, preparing the identified set of data for use in analysis, analyzing at least a portion of said data in an automated fashion as required to identify one or more statistics selected from the group consisting of pattern, trend, ratio, average, elapsed time period, percentage, variance, standard deviation, monthly total and combinations thereof, and using at least a portion of said statistics and data to develop a model of enterprise financial performance using automated learning. (Sandretta's steps 1 through ten, and then additional alternative steps (1) through (6) include these steps, followed by multiple iterations. These are the characteristics of an automated learning process (Col. 10, ll. 1-Col. 12, l. 55). Sandretto's general methodology and objectives are outlined in Col. 8, l. 52 – Col. 9, l. 67.

It would have been obvious to an ordinary practitioner of the art at the time of Applicant's invention to have used Sandretto's disclosure combined with the practitioner's own knowledge to make obvious adjustments in order to produce an intelligent method for analyzing commerce data using a computer, motivated by the desire to offer a valuation model which fully utilizes current information that affects asset risk and which can be used for virtually any asset and potential asset (Sandretto, Col. 9, ll. 56-67).

Re. claims 87 & 88, Sandretto discloses a method of predictive modeling, comprising:

Re. Claim 87, providing a description of a plurality of elements of value that support a business enterprise; generating a predictive model that mathematically expresses dynamic characteristics and behavior of the elements of value using said descriptions; and identifying one or more changes that improve an operational performance and financial states of the business enterprise using said model. These steps are basic quantitative (meaning mathematic) predictive modeling techniques for forecasting future value and thereby also estimating present value of a firm or of financial assets. As stated in various ways in the rejections of claims 43-86, Sandretto discloses or suggests these method steps. Sandretto liberally uses the word 'model' throughout his disclosure to describe his teaching. It is also obvious to a practitioner that Sandretto's modeling has predictive purposes ("inputting economic variables expected to influence future asset values", Abstract – ll. 1-2).

The reasons Sandretto discloses or suggests these claimed limitations are as follows:

- one of the places which describes "providing a description of a plurality of elements of value that support a business enterprise" is in Col. 10, ll. 1-7;
- generating a predictive model that mathematically expresses dynamic characteristics and behavior of the elements of value using said descriptions is described in Col. 8, l. 52 – Col. 9, l. 20; and
- "identifying one or more changes that improve an operational performance and financial states of the business enterprise using said model" is disclosed by Sandretto because his disclosure implicitly and obviously has this as its central purpose by using modeling to identify and quantify risk and opportunities, and to suggest adjustments which will improve operational and financial performance of a firm (Abstract, l. 2 – "to influence future asset values").

Re. Claim 88, wherein the predictive model mathematically expresses the dynamic characteristics and behavior of each element of value as including direct effects and indirect effects from each element of value. Sandretto dynamic modeling method quantifies the risk profile of each element value and demonstrates the direct effects of an element of value through the identification of each element's risk measures, both input risk (Col. 9, l. 3) and

output risk (Col. 9, l. 14). The identifying of an asset's operating (direct), financing and accounting (indirect) characteristics encompasses direct and indirect effects.

Re. claims 87 & 88, it would have been obvious to an ordinary practitioner of the art at the time of Applicant's invention to have used Sandretto's disclosure combined with the practitioner's own knowledge to make obvious adjustments in order to produce a method of predictive modeling, motivated by the desire to offer a valuation model which fully utilizes current information that affects asset risk and which can be used for virtually any asset and potential asset (Sandretto, Col. 9, ll. 56-67).

9. Claim 86 is rejected under 35 U.S.C. 103(a) as being disclosed by Sandretto as applied to claim 85 above, and further in view of Barr et al. (US Patent 5,761,442, hereafter Barr).

Re. Claim 86, Sandretto does not explicitly disclose a method which comprises using a plurality of genetic algorithms to automatically learn from the data by using processing steps selected from the group consisting of fitness measure re-scaling, random mutation, recalibrating target fitness levels, selective crossover, selective carry-forward and combinations thereof. However, Barr discloses the use of commercial optimizers such as the "Solver" which is part of the Excel spreadsheet program from Microsoft corporation, the "Evolver", a genetic algorithm based program from Axcellis Inc. ..., or software packages which are available from the Harvard Business School ...". Barr discloses that "such commercial portfolio optimizers can be integrated as part of data processing system 310 (Col. 13, ll. 26-41). The Barr patent is titled "Predictive neural network means and method for selecting a portfolio of securities wherein each network has been trained using data relating to a corresponding security". Barr further discloses that "other commercial products or custom software can be used and developed by persons skilled in the art on the basis of the disclosure". It would have been obvious for the practitioner to select from these available genetic algorithms techniques such as fitness measure re-scaling, random mutation, recalibrating target fitness levels, selective crossover, selective carry-forward and combinations thereof to automatically learn from the data. Consequently, it would have been obvious to an ordinary practitioner of the art at the time of Applicant's invention to have

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combined Sandretto's disclosure with the disclosure of Barr, combined with the practitioner's own knowledge, to make use of a plurality of genetic algorithms to automatically learn from the data, motivated by the desire to offer a valuation model which utilizes neural nets, genetic algorithms and optimization techniques to effectively combine technical and fundamental information in a computerized framework (Sandretto, Col. 9, ll. 56-67).

Response to Arguments

10. Applicant's arguments filed on November 11, 2005 with respect to claims 43-79 have been fully considered but they are not persuasive.

This Office Action is non-final because of the addition of rejections under 35 USC 101 and 35 USC 112.

ARGUMENT A:

"In the 11 October 2005 Office Action, claims 51, 63 and 76 are rejected under §103 as being unpatentable over Sandretto in view of Jost. The Assignee respectfully traverses the §103 rejections of claims 51, 63 and 76 in two ways. **First**, by noting that the Office Action does not teach how the cited references could be combined to produce anything useful. **Second**, by noting that the cited combination of references fails to establish a prima facie case of obviousness. The Assignee also notes that there are still other ways in which all §103 obviousness rejections in the 11 October 2005 Office Action for claims 51, 63 and 76 can be traversed". (Remarks: broadly - p. 13, ll. 7-10; in detail - p. 13, l. 5 – p. 15, l. 5)". (**Bolding added**).

RESPONSE:

Applicant is directed to the 2006 Circuit Court opinion of *In re Kahn* regarding obviousness combinations:

"A suggestion, teaching, or motivation to combine the relevant prior art teachings does not have to be found explicitly in the prior art, as the teaching, motivation, or suggestion may be implicit from the prior art as a whole, rather than expressly stated in the references. . . . **The test for an implicit showing is what the combined teachings, knowledge of one of ordinary skill in the art, and the nature of the problem to be solved as a whole would have suggested to those of ordinary skill in the art.** In re Kotzab, 217 F.3d 1365, 1370 (Fed. Cir. 2000). However, rejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, **there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.** See Lee, 277 F.3d at 1343-46; Rouffett, 149 F.3d at

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1355-59. This requirement is as much rooted in the Administrative Procedure Act, which ensures due process and non-arbitrary decisionmaking, as it is in § 103. See id. at 1344-45." In re Kahn, Slip Op. 04-1616, page 9 (Fed. Cir. Mar. 22, 2006)." (**Bolding added**).

In this case, the examiner made a judgement that the ordinary practitioner of the art, had he or she seen the Sandretto and Jost references at the time of Applicant's invention, would have seen the teachings, suggestions and obviousness of selectively using the disclosures of the two references in order to develop the features and limitations of claims 52, 63 and 76. Sandretto and Jost both present computer automated applications. Modifying the software and even the hardware employed to operate Sandretto's disclosure with additional software and perhaps additional hardware to add the neural networks teaching by Jost is eminently doable in the computer arts. The practitioner would have had the knowledge and skill to achieve the combinations through employment of appropriate hardware and software manipulations. The examiner's judgement is based on the judgement that the ordinary practitioner in this kind of invention is either solely competent in finance and strategic evaluations of the firm and is sufficiently knowledgeable to get the computer implementation done, or is sufficiently competent in working with one or more collaborating practitioners, assistants or a vendor who have the required computer related knowledge and skills. The details of these computer techniques are outside the scope of this examination and are not claimed. The rational underpinning for this judgement is based on the fact that computer systems hardware and software are extremely flexible, unlike many scientific and technical areas of art where that is not the case. For example, an invention employing a gasket with certain required stiffness characteristics to achieve a certain performance quality cannot have prior art applied to it based on a flexible gasket. Many court opinions are based on such specific factual scenarios where the technical facts may have been misunderstood by an examiner. The examiner is not required to give a technical exposition of how the ordinary practitioner would apply his technical know-how regarding computer systems, since this has been classified as a business methods application. Rather, the burden of proof falls on applicant to present a reasonable case to disprove the examiner's judgement. This requirement is supported by the following

court opinion: ("[T]he PTO can require an applicant to prove that the prior art products do not necessarily or inherently possess the characteristics of his [or her] claimed product. Whether the rejection is based on inherency' under 35 U.S.C. 102, on prima facie obviousness' under 35 U.S.C. 103, jointly or alternatively, the burden of proof is the same...[footnote omitted]." The burden of proof is similar to that required with respect to product-by-process claims. *In re Fitzgerald*, 619 F.2d 67, 70, 205 USPQ 594, 596 (CCPA 1980) (quoting *In re Best*, 562 F.2d 1252, 1255, 195 USPQ 430, 433-34 (CCPA 1977)).").

ARGUMENT B: Re. the rejection of claims 43-51, 53-62, 64-75 and 77-79 under 35 USC 102 as being anticipated by Sandretto.

The examiner has failed to establish a prima facie case of anticipation (p. 10, ll. 4-5 by

- (1) for many of the claims, failing to describe every element of the claim based on *Verdegaal Bros. V. Union Oil Co. of California* (p. 10, ll. 7-13);
- (2) for many of the claims, failing to "provide the same level of detail that is present in the claim based on *Richardson v. Suzuki Motor Co.* (p. 10, ll. 14-20); and
- (3) for many of the claims, failing to describe the basis in fact or technical reasoning that is required to support the allegations regarding allegedly inherent characteristics contained in *Sandretto* (p. 10, ll. 21-29).

Further, Applicant has taken a broad brush approach to challenging the alleged missing elements in *Sandretto* by submitting two tables as follows and an introduction:

The tables below itemizes the presence of up to three failure modes for every claim rejected under § 102. The "inherency not explained" failure mode was included for both claims where inherency was not explained in accordance with the requirements noted in MPEP 2112 and for claims where the Office Action seems to indicate that *Sandretto* provides express support for claim limitations that do not appear to be expressly supported by the *Sandretto* specification.

	General failures include:	Specific failures include:
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43	Missing elements, insufficient detail and inherency not explained	Missing hidden layer, missing network models, lack of detail aggregating data, lack of detail impact and inherency not explained
44	Missing elements and insufficient detail	Missing revenue, expense and capital change
45	Missing elements, insufficient detail and inherency not explained	No value driver summary, no impact on other elements of value, lack of detail
46	Missing elements, insufficient detail and inherency not explained	No weights, no revenue, no expense, no capital change
47	Missing elements, insufficient detail and inherency not explained	No weights, no revenue, no expense, no capital change
48	Missing elements and insufficient detail	No point in time from sequential point in time
49	Missing elements, insufficient detail and inherency not explained	No relative contribution, no net present value, no combination
50	Missing elements, insufficient detail and inherency not explained	No brands, customers, employees, partnerships, vendors, etc.
52	Missing elements and insufficient detail	No growth options and/or market sentiment
53	Missing elements and insufficient detail	No display of growth options, market sentiment, value by element, etc.
54	Missing elements, insufficient detail and inherency not explained	Missing hidden layer, missing network models, lack of detail aggregating data, lack of detail impact and inherency not explained
55	Missing elements, insufficient detail and inherency not explained	Missing revenue, expense and capital change
56	Missing elements, insufficient detail and inherency not explained	No value driver summary, no impact on other elements of value, lack of detail
57	Missing elements, insufficient detail and inherency not explained	No weights, no revenue, no expense, no capital change
58	Missing elements, insufficient detail and inherency not explained	No weights, no revenue, no expense, no capital change
59	Missing elements, insufficient detail and inherency not explained	No weights, no revenue, no expense, no capital change
60	Missing elements and insufficient detail	No point in time, sequential point in time
61	Missing elements and insufficient detail	No relative contribution, no net present value, no combination
62	Missing elements, insufficient detail and inherency not explained	No brands, customers, employees, partnerships, vendors, etc.
64		Discusses analyzing separable assets for a firm, independent claim is missing elements
65	Missing elements and insufficient detail	No growth options and/or market sentiment

	General failures include;	Specific failures include:
6fi	Missing elements and Insufficient detail	No basic financial system, human resource system, advanced financial system, sales system, operations system, accounts receivable system, accounts payable system, capital asset system, inventory system, invoicing system, payroll system, purchasing system, the

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67	Missing elements, insufficient detail and inherency not explained	Missing hidden layer, missing network models, lack of detail aggregating data, lack of detail impact and inherency not explained
68	Missing elements and insufficient detail	Missing revenue, expense and capital change
69	Missing elements and insufficient detail	No value driver summary, no impact on other elements of value, lack of detail
70	Missing elements, insufficient detail and inherency not explained	No weights, no revenue, no expense, no capital change
71	Missing elements, insufficient detail and inherency not explained	No weights, no revenue, no expense, no capital change
72	Missing elements, insufficient detail and inherency not explained	No weights, no revenue, no expense, no capital change
73	Missing elements and insufficient detail	No point in time from sequential point in time
74	Missing elements and insufficient detail	No relative contribution, no net present value, no combination
75	Missing elements, insufficient detail and inherency not explained	No brands, customers, employees, partnerships, vendors, etc.
77		Discusses analyzing separable assets for a firm, independent claim is missing elements
78	Missing elements and insufficient detail	No growth options and/or market sentiment
79	Missing elements, insufficient detail and inherency not explained	No basic financial system, a human resource system, an advanced financial system, a sales system, an operations system, accounts receivable system, accounts payable system, capital asset system, inventory system, invoicing system, payroll system, purchasing

Summarizing the above, the 11 October 2005 Office Action has failed to identify the facts required to establish a prima facie case of anticipation for a single claim. The complete failure to identify anticipation at the claim level clearly illustrates the fact that the cited reference is not even remotely similar to the claimed invention. As noted in MPEP 2112, anticipation requires that a substantial identity be established. Taken together, these failures provide **additional evidence that the claimed invention** for producing concrete, tangible and *useful results is new, novel and non-obvious*. The Assignee notes that there are still other ways in which all §102 anticipation rejections in the 11 October 2005 Office Action for claims 43 — 50, 52 — 62, 64 — 75 and 77 — 79 can be traversed.

RESPONSE:

Applicant at pp. 5-21 denies the rejections without offering argument or evidence to refute the rejections. This fails to comply with 37 CFR 1.111(b) because applicant's arguments amount to a general allegation that the claims define a patentable invention

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without distinctly and specifically pointing out the supposed errors in the examiner's action. The last rejection is accordingly repeated.

Conclusion

12. Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Siegfried Chencinski whose telephone number is (571)272-6792. The Examiner can normally be reached Monday through Friday, 9am to 6pm.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Hyung S. Sough, can be reached on (571) 272-6799.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Any response to this action should be mailed to:

Commissioner of Patents and Trademarks, Washington D.C. 20231

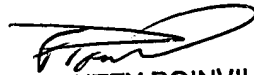
or (571)273-8300 [Official communications; including After Final communications labeled "Box AF"]

(571) 273-6792 [Informal/Draft communications, labeled "PROPOSED" or "DRAFT"]

Hand delivered responses should be brought to the address found on the above USPTO web site in Alexandria, VA.

SEC

April 28, 2006


FRANTZY POINVIL
PRIMARY EXAMINER
Au3628